

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JERALD R. MELCHER and DEBRA A. SPEICHERT

Appeal No. 97-0695
Application No. 08/273,466¹

ON BRIEF

Before LYDDANE, McQUADE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 3 through 8. Claims 1 and 2 have been

¹ Application for patent filed July 11, 1994. According to the appellants, the application is a division of Application No. 08/000,205, filed January 4, 1993, now U.S. Patent No. 5,358,480, which was a division of Application No. 07/823,366, filed January 21, 1992, now U.S. Patent No. 5,212,847.

Appeal No. 97-0695
Application No. 08/273,466

withdrawn from consideration under 37 CFR § 1.142(b) as being
drawn to a nonelected invention.

We AFFIRM-IN-PART and enter new rejections pursuant to
37 CFR § 1.196(b).

Appeal No. 97-0695
Application No. 08/273,466

BACKGROUND

The appellants' invention relates to a method of fabricating handles. Claims 3 and 7 are representative of the subject matter on appeal and a copy of those claims, as they appear in the appendix of the appellants' brief, is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Ager	2,510,490	June
6, 1950		
Janssen	4,856,136	Aug. 15,
1989		

Claims 3 through 8 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention.

Claims 3, 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Janssen.

Appeal No. 97-0695
Application No. 08/273,466

Claims 4 through 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Janssen in view of Ager.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the § 103 and § 112 rejections, we make reference to the examiner's answer (Paper No. 12, mailed September 16, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 11, filed June 17, 1996) for the appellants' arguments thereagainst.

OPINION

Initially, we note that the objection to the drawings under 37 CFR § 1.83(a) made by the examiner in the final rejection relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue regarding this objection raised by the appellants on pages 13-14 of the brief.

Appeal No. 97-0695
Application No. 08/273,466

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appeal No. 97-0695
Application No. 08/273,466

The indefiniteness issue

We do not sustain the rejection of claims 3 to 8 under 35 U.S.C. § 112, second paragraph.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 189 USPQ 149, 151 (CCPA 1976).

On page 3 of the answer, the examiner determined that

[t]he term "adapted to" in claims 3 and 4 is vague and unclear because it does not distinctly claim the characteristics of the "handles."

It is our opinion that the "adapted to" language at issue would be understood as merely reciting the intended use of the handles. Accordingly, the metes and bounds of the claimed invention have been defined with the necessary degree of precision and particularity required by the second paragraph of 35 U.S.C. § 112.

The obviousness issue

The test for obviousness is what the combined teachings of the applied prior art would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art to make the modifications necessary to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or

Appeal No. 97-0695
Application No. 08/273,466

hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Claims 3, 7 and 8

We do not sustain the rejection of claims 3, 7 and 8 under 35 U.S.C. § 103 as being unpatentable over Janssen.

Claim 3 is drawn to a method of fabricating a plurality of handles including, inter alia, the steps of (1) forming a plurality of strips shaped as right, regular parallelopipeds, and

(2) forming barbs on each of the strips. Since the barbs of step (2) are formed on each of the strips formed in step (1), the steps must occur in the order specified in the claim.

Thus, claim 3 requires forming a plurality of strips shaped as right, regular parallelopipeds, and then forming barbs on each of the strips.

Janssen discloses an applicator for paint and other fluids. Figure 1 of Janssen shows an exploded perspective view of a preferred brush 10 with the handle member 14 removed from the cavity 42 of the head member 30. The handle member 14 comprises a gripping section 16, a head mounting section 20, and a circumferential skirt 22 which separates gripping

section 16 and head mounting section 20. Janssen teaches that the handle member 14 is preferably constructed of a lightweight, durable plastic, however it may be constructed of wood or other suitable material. Further, the handle member 14 is preferably a molded material of sufficient strength, structure, and shape to provide support and control for a mounted head member designed for the application of paint and other coating materials. The head mounting section 20 is a flat plate of generally rectangular shape containing laterally extending serrations 24 designed to engage the mounted head member 30. The circumferential skirt 22 permits separation of handle gripping section 16 from head mounting section 20.²

As shown in Figure 2, when head member 30 is fully mounted on head mounting section 20, the laterally extending serrations 24 of head mounting section 20 engage the cavity defining surfaces to retain head member 30 on handle member 14.

Additionally, Janssen discloses that in order to provide optimum gripping of the brush by a user, the elongate gripping section 16 should be generally about 10 cm in length

² See column 5, lines 1-35, of Janssen.

and generally about at least 1 cm in width. Furthermore, the head mounting section 20 is wider than the gripping section 16 and the ratio of the length of the gripping section 16 to the length of the head mounting section 20 is about 2:1, however, such ratio may vary depending on the sizes of the head member 30 and the intended use.³

We agree with the appellants (brief, pp. 16-18) that Janssen does not teach or suggest the subject matter recited in claims 3, 7 and 8. In this rejection the examiner presents no evidence as to why it would have been obvious to form a plurality of strips shaped as right, regular parallelopipeds, and then form barbs on each of the strips. While Janssen teaches having serrations (i.e., barbs) 24 on a flat plate 20 of generally rectangular shape, Janssen does not teach or suggest the fabrication steps recited in independent claim 3. Additionally, contrary to the examiner's position with regard to the limitations recited in claim 7, Janssen does not teach or suggest the formation of at least four barbs on each of

³ See column 2, lines 43-68, of Janssen.

Appeal No. 97-0695
Application No. 08/273,466

four corners of each handle. Accordingly, the examiner has not presented a prima facie case of obviousness with respect to claims 3, 7 and 8.

Claims 4 through 6

The rejection of claims 4 through 6 under 35 U.S.C. § 103 as being unpatentable over Janssen in view of Ager is sustained.

On page 6 of the answer, the examiner determined that

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the barbs (24) of Janssen as suggested by Ager because they both are recognized ways of retaining a pad on a handle.

Claims 4 through 6 depend directly or indirectly on independent claim 3. Accordingly, we must first determine if the subject matter of claim 3 is unpatentable under 35 U.S.C. § 103 over Janssen in view of Ager. The teachings of Janssen have been previously set forth.

Ager discloses an applicator stick used in surgical treatments of the body. The stick 10 is made of wood. As shown in Figure 4, the applicator stick 10 is roughened by barbing the end of the stick to provide barbs 17 thereon, arranged in circular rows with the barbs of alternate rows offset respectively with the barbs of the rows therebetween.⁴ The barbs 17 prevent removal of a pledget of cotton 14 from

⁴ See column 2, lines 33-40, of Ager.

the end of the stick when the stick is being used in the treatment of the body.⁵

In applying the above noted test for obviousness, we reach the conclusion that it would have been obvious to one of ordinary skill in the art at the time of the appellants' invention to fabricate a plurality of Janssen's generally rectangular (i.e., right, regular parallelopiped) head mounting sections 20 from wood as suggested by Janssen and to then form the serrations thereon by barbing the wood as suggested and taught by Ager. Additionally, we agree with the examiner's determinations that (1) Janssen's head mounting section 20 is formed from an autoclavable material since both wood and plastic as taught by Janssen are well suited to undergo treatment in an autoclave, and (2) the recited dimensional limitations are matters of design choice lacking any criticality since they solve no stated problem especially since the appellants have not contested otherwise.

⁵ See column 1, lines 8-15, of Ager.

Appeal No. 97-0695
Application No. 08/273,466

In view of the above, it is our determination that all the limitations of claim 3 are met by the combined teachings of Janssen and Ager.

Dependent claim 4 adds to claim 3 the limitation that

the step of forming barbs includes a step of making a plurality of cuts in at least one row, each cut being formed as herringbone, pointing backwardly away from said handle end that is adapted to be inserted in an opening in said pad.

The appellants argue (brief, pp. 19-20) that "[n]either reference has such a herringbone design whereas the applicants device does meet the definition of a herringbone." We do not agree. As pointed out by the examiner (answer, p. 7), the row of barbs shown in the appellants' drawings do not display a true herringbone configuration since the direction of the slant does not alternate row by row. This is due to the fact that the appellants' barbs are chevron-shaped cuts (specification, p. 7). Since the barbs 17 as shown in Figure 4 of Ager are also formed by chevron-shaped cuts, it is our determination that it would have been obvious to one of

ordinary skill in the art at the time of the appellants' invention to form the serrations on the head mounting sections 20 of Janssen by making a plurality of cuts in at least one row, each cut being formed as herringbone (e.g., chevron-shaped), pointing backwardly away from the handle end as suggested and taught by Ager.

Dependent claim 5 adds to claim 3 the limitation that

the step of forming barbs on one end of said strip includes a step of forming at least four barbs with at least two of said four barbs being cut into a periphery of the strip near the one end in spaced apart relation from each other but in a common plane at an angle to a longitudinal axis of the strip to provide support within the pad on either side of the strip.

The appellants' argument (brief, p. 20) that neither Ager nor Janssen has a teaching which defines the location of the cuts/barbs so as to insure that once the end of the handle is inserted into the pad, the herringbone cuts/barbs provide an even grip is unpersuasive for the following reasons. First, the argument is not commensurate in scope with the claim language in that claim 5 does not call for either herringbone cuts/barbs or that the cuts/barbs provide an even grip.

Secondly, nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co. Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). Lastly, the combination of Janssen and Ager, as modified above with respect to claim 3, would have formed at least four barbs with at least two of the four barbs being cut into a periphery of each head mounting section near the one end in spaced apart relation from each other but in a common plane at an angle to a longitudinal axis of the head mounting section which would inherently provide support within the head member 30 of Janssen on either side of the head mounting section.

Dependent claim 6 adds to claim 5 the limitation that

the step of forming barbs includes cutting slits into said handle sufficiently long to provide a firm grip within the pad wherein the slits extend a first distance equal to at least 3 percent of a second distance through the handle; said second distance being the distance through the handle in a direction perpendicular to the longitudinal axis; said first distance extending at an angle to the longitudinal axis to form barbs that extend outwardly and rearwardly whereby they are capable of catching

within the pad to prevent removal of the handle from the pad without tearing the pad.

The appellants argue (brief, pp. 20-22) that neither cited reference discloses barbs formed by making a plurality of slits wherein the slits extend a first distance equal to at least 3 percent of a second distance through the handle. The second distance being the distance through the handle in a direction perpendicular to the longitudinal axis with the first distance extending at an angle to the longitudinal axis so that the barbs extend outwardly and rearwardly. We find this argument unconvincing for the following reasons. First, as stated above, nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. Secondly, we agree with the examiner's determination (answer, p. 6) that the recited dimensional limitations are matters of design choice lacking any criticality since they solve no stated problem especially since the appellants have not contested otherwise. Lastly, the combination of Janssen and Ager, as modified above with respect to claims 3 and 5, would

Appeal No. 97-0695
Application No. 08/273,466

have formed barbs by cutting slits into each head mounting section of Janssen as suggested and taught by Ager. As shown in Figure 4 of Ager, the barbs 17 are made by cutting slits into the wood stick 10 wherein the slits would appear to extend a first distance equal to at least 3 percent of a second distance through the stick, wherein the second distance is the distance through the stick in a direction perpendicular to the longitudinal axis and the first distance extends at an angle to the longitudinal axis to form barbs that extend outwardly and rearwardly whereby they are capable of catching a pledget of cotton to prevent removal of the stick from the pledget of cotton.

For the reasons stated above, we sustain the examiner's rejection of claims 4 through 6 under 35 U.S.C. § 103.

New grounds of rejection

In accordance with 37 CFR § 1.196(b), we introduce the following new grounds of rejection.

Appeal No. 97-0695
Application No. 08/273,466

Claim 3 is rejected under 35 U.S.C. § 103 as being unpatentable over Janssen in view of Ager, for the reasons set forth above in the discussion of claims 4 through 6.

Claim 8 is rejected under 35 U.S.C. § 103 as being unpatentable over Janssen in view of Ager, for the reasons set forth above with respect to claim 3 and for the reasons set forth below.

Dependent claim 8 adds to claim 3 the limitation that each of the formed strips has a uniform cross-section along its length.

As shown in Figures 1 to 3, Janssen's head mounting section 20 without the serrations 24 has a uniform cross-section along its length. Thus, the strips of wood prior to forming the barbs therein as taught by Ager would have a uniform cross-section along their length.

CONCLUSION

Appeal No. 97-0695
Application No. 08/273,466

To summarize, the decision of the examiner to reject claims 3 through 8 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 3, 7 and 8 under 35 U.S.C. § 103 is reversed; the decision of the examiner to reject claims 4 through 6 under 35 U.S.C. § 103 is affirmed; and a new rejection of claims 3 and 8 under 35 U.S.C. § 103 has been added pursuant to provisions of 37 CFR § 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof. 37 CFR § 1.197.

With respect to the new rejection under 37 CFR § 1.196(b), should the appellants elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event the appellants elect this

Appeal No. 97-0695
Application No. 08/273,466

alternate option, in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

Appeal No. 97-0695
Application No. 08/273,466

No period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

WILLIAM E. LYDDANE)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 97-0695
Application No. 08/273,466

VINCENT L. CARNEY
P.O. BOX 80836
LINCOLN, NE 68501-0836

APPENDIX

3. A method of fabricating a plurality of handles each adapted to have a corresponding one handle end inserted in a corresponding one pad end of a plurality of pads including the steps of:

forming a plurality of strips shaped as right, regular parallelopipeds having dimensions of at least one inch by one-eighth of an inch by one-thirty-second of an inch from an autoclavable material; and

forming barbs on the one handle end of each of said strips whereby said handles are formed with barbs on each of said one handle ends.

7. A method of fabricating a plurality of handles in accordance with claim 3 wherein each of said one handle end of said plurality of said handles has four corners and at least four barbs are formed in each of the four corners of each handle.

APPEAL NO. 97-0695 - JUDGE NASE
APPLICATION NO. 08/273,466

APJ NASE

APJ LYDDANE

APJ McQUADE

DECISION: **AFFIRMED-IN-PART;**
1.196(b)

Prepared By: Delores A. Lowe

DRAFT TYPED: 30 Oct 97

FINAL TYPED:

3 MAN CONF